



1624

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Application Number	10/033,241
Filing Date	December 28, 2001
First Named Inventor	SF Jacobsen
Art Unit	1624
Examiner Name	Brenda Libby Coleman
Attorney Docket Number	00394.US1

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Total Number of Pages in This Submission

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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Pharmacia & Upjohn Company, Mary J. Hosley, Registration No. 48,324
Signature	Mary J. Hosley
Date	September 10, 2003

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PATENT/Docket No. 00794 US1

Serial No. 10/033,241

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 16 2003
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Art Unit : 1624
Examiner : Brenda Coleman
Applicant(s) : SF Jacobsen, KM Merchant, EJ Jacobsen
Serial Number : 10/033,241
Filed : December 28, 2001
For : Substituted Indolines

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Sir:

This is in response to the September 10, 2003, Paper No. 6 office action. Please amend the claims as discussed herein and as presented in the Amendment included with this response.

35 U.S.C. § 112

The Office Action states that claims 1-6, 9, 10, and 13-26 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, then the *Wand* factors were referenced. Examiner rejected the claims because of the inclusion of "prodrugs". Applicants traverse.

The test for enablement is whether the experimentation needed to practice the invention is undue or unreasonable. *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988). The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited – Charge Cell Culture Microcarriers*, 221 U.S.P.Q. 1165, 1174 (Int'l Trade Comm) 1983), *Aff'd. sub. nom.*, *Massachusetts Institute of Technology v. A.Z.B. Fortia*, 774 F.2d 1104, 227 U.S.P.Q. 428 (Fed. Cir. 1985). Nothing more than objective enablement is required, and therefore, it is irrelevant